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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/600,306   | 06/18/2003  | Yen-Li Chang         | 453-014             | 7682             |
| 7590   | 05/04/2004  |                      | EXAMINER            |                  |
| John G. Chupa<br>Law Offices of John Chupa & Associates, P.C.<br>Suite 50<br>28535 Orchard Lake Road<br>Farmington Hills, MI 48334 |             |                      | WONG, STEVEN B      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3711                |                  |
| DATE MAILED: 05/04/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application N .</b><br>10/600,306 | <b>Applicant(s)</b><br>CHANG, YEN-LI |  |
|                              | <b>Examiner</b><br>Steven Wong       | <b>Art Unit</b><br>3711              |  |

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

*Specification*

1. The disclosure is objected to because of the following informalities: the specification is replete with grammatical errors. The applicant should carefully read the specification and correct the errors. For example, on page 1, line 4, the language "is relating to"; on page 1, lines 4 and 5, "having decorated grooved partition rib"; on page 1, line 5 "which formed by heat transformation".

Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with grammatical errors. In claim 1, line 2, the language "carcass adhere" is inapt. In claim 1, line 2, the language "the panel of cover" is inapt. In claim 1, lines 3 and 4, the language to the surface of carcass" is inapt. In claim 1, lines 4 and 5, the language which formed during the vulcanize process" is inapt. Appropriate correction is required.

Further, in claim 1, the language on lines 4 and 5 is unclear in positively defining the structure for the basketball. The language "the configuration" is unclear in setting forth a particular surface for the partition rib. Also, it is unclear what surface is produced by the vulcanizing process.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Guenther et al. (Guenther). Insofar as the claims may be understood, Guenther anticipates the claimed structure. Regarding claims 1 and 2, Guenther discloses a basketball comprising an bladder (11), a thread layer (15), a carcass (16, 20) adhered on the thread layer and a plurality of cover panels (12) adhered to the carcass. Note Figure 6, element 20 of Guenther pointing to a longitudinal groove in the ribs. Note also column 3, lines 50-57 of Guenther stating that the ribs, carcass and cover panels are heated to complete the ball. The applicant should not that claims 1 and 2 are considered to be product-by-process claims. The claims both contain limitations relating to the method of producing the ball (the vulcanize process and the heat transfer printing process). See MPEP 2113. Here, Guenther provides the same product as that claimed and thus, the claim is unpatentable even if the prior product was made by a different process.

6. Regarding claims 5-7, note column 3, lines 24-30 of Guenther stating that the cover may be formed from leather, synthetic leather or rubber.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guenther et al. Regarding claim 3, note column 3, lines 34-40 stating that the channels may be made of different colors. It would have been obvious to one of ordinary skill in the art to compose the channel of Guenther from two colors in order to make the channels more distinctive.

9. Regarding claim 4, the recitation for the indicia on the ball to be lines, stripes, letters, figures or numbers is considered to be a mere change in the indicia on the channels. Given the teaching of Guenther to color the channels, the mere change of colors to numbers, figures, lines or stripes would simply reside in the meaning and information conveyed by the printed matter and such differences are not considered to be patentable differences. It would have been obvious to one of ordinary skill in the art to replace the coloring with figures, numbers, stripes, lines or letters in order to highlight the channels by providing another form of indicia.

10. Regarding claim 8, it would have been obvious to one of ordinary skill in the art to provide the ball of Guenther with a polyurethane or polyvinylchloride cover in order to take advantage of that material's well known physical characteristics.

11. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guenther et al. in view of Williams (D329,674). Williams reveals a practice basketball construction including indicia thereon for indicating the user's proper hand placement for shooting the basketball. The Figures of Williams clearly show the indicia extending across the channels of the ball. It would have been obvious to one of ordinary skill in the art to provide the indicia taught by Williams on the ball of Guenther in order to indicate to a user the proper hand

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placement for shooting the basketball. Further, by providing the indicia on the ball of Guenther, the channels will include lines thereon. Further, it would have been obvious to one of ordinary skill in the art to provide the lines for the hand placement in a contrasting color to the channels. By providing contrasting colors, the ball of Guenther in view of Williams will provide two colors for the channel.

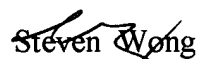
*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
April 30, 2004